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09/843,413	04/25/2001	Tony M. Pearce	5066 P	9340

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EXAMINER

HO, THOMAS Y

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/843,413

Applicant(s)

PEARCE, TONY M.

Examiner

Thomas Y Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Greenawalt USPN4528705.

As to claim 4, Greenawalt discloses a pillow comprising:

- An inflatable bladder 34.
- A resilient material 12 (col.2, ln.15-18) covering both the top and bottom of said bladder 34.
- Said resilient material 12 being sufficiently flexible to accommodate inflation of said bladder (34).
- Wherein said resilient material 12 has top/bottom symmetry (fig.4) so that the pillow can be turned over for use on either side.
- Wherein said bladder 34 may be inflated and deflated to adjust contour of the pillow from nearly flat to fully contoured (col.2, ln.60-62).
- Wherein contour of the pillow is adjustable in discrete increments by inflating said bladder 34 in discrete increments.

As to claim 7, Greenawalt discloses a pillow comprising:

- A bladder 34 that may be inflated by placement of a gas therein.



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- A resilient material covering 12 overlaying both the top and bottom of said bladder 34.
- Said resilient material covering 12 being sufficiently flexible to accommodate inflation of said bladder 34.
- Wherein contour of the pillow is adjustable from nearly flat to fully contoured by inflation of said bladder 34 (col.2, ln.60-62).
- Wherein contour of the pillow is adjustable in discrete increments.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenawalt USPN4528705 in view of Walpin USPN6182312.

As to claim 1, Greenawalt discloses a pillow comprising:

- An inflatable bladder 34.
- Said inflatable bladder 34 capable of being inflated to a variety of levels by placing a gas therein.
- A resilient material 12 (col.2, ln.15-18) covering both the top and bottom of said bladder 34.
- Said resilient material 12 being sufficiently flexible to accommodate inflation of said bladder 34.



- Wherein said combination of bladder 34 and covering 12 is symmetrical top to bottom so that it can be turned over for use on either side.
- Wherein said bladder 34 may be inflated in discrete increments by use of a pump 38.

Greenawalt fails to disclose or suggest the following limitations:

- Wherein said resilient material is overlaid with another padding material selected from the group consisting of polyurethane foam, memory foam, latex foam rubber, fiber batting, buckling elastomers, and a resilient material consisting of discontinuous pieces of flexible material joined together by low durometer, high elongation elastomeric material.

Walpin discloses a pillow wherein a resilient material 10 is overlaid with another padding material 50 made of memory foam (col.4, ln.1-10) to conform to the shape of a user's head and neck region with no need for a break-in period. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the pillow disclosed by Greenawalt to have an overlaid padding material, as taught by Walpin, to conform to the shape of a user's head without a need for a break-in period.

As to claim 10, Walpin discloses the following limitations not disclosed by Greenawalt:

- Wherein said resilient material 10 covering is selected from the group consisting of polyurethane foam, memory foam, latex foam rubber, fiber batting, buckling elastomers, and a resilient material consisting of discontinuous pieces of flexible material joined together by low durometer, high elongation elastomeric material.



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Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greenawalt USPN4528705 in view of Walpin USPN6182312, and further in view of Greenawalt USPN4501034.

As to claim 2, Greenawalt USPN4528705 fails to disclose or suggest the following limitations:

- A second inflatable bladder.

Greenawalt USPN4501034 discloses a pillow having a second inflatable bladder 32 (col.2, ln.55-60) to increase the possibility of firmness variation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the pillow disclosed by Greenawalt USPN4528705 to have a second inflatable bladder, as taught by Greenawalt USPN4501034, to increase the possibility of firmness variation.

Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenawalt USPN4528705 in view of Walpin USPN6182312, and further in view of Pekar USPN5372487.

As to claim 3, Greenawalt discloses a pillow further comprising:

- A pump 38 integral to the pillow.

Greenawalt fails to disclose or suggest the following limitations:

- The pump including a pump bladder having bladder walls.
- An orifice on a bladder wall through which a gas may travel as desired.
- Resilient means located in said pump bladder.
- Said resilient means serving to re-expand said pump bladder after it has been contracted by a squeezing force.



- A one-way valve between said pump bladder and said inflatable gas-containing bladder to permit the pump to force gas into said inflatable gas-containing bladder.
- A bleed valve on said inflatable gas-containing bladder for permitting gas to escape therefrom.

Pekar discloses a pump having a pump bladder 39, an orifice 47, resilient means 31, a one-way valve 16, and a bleed valve 20, so that the user will not have to release and uncover a hole during each stroke of the pump (col.3, ln.25-27), and because the check valve is soft and pliable in construction and lends itself to ease of co-assembly in various types of inflatable bladder applications (col.1, ln.42-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the pump disclosed by Greenawalt with another pump, as taught by Pekar, so the user will not have to release and uncover a hole during each stroke.

As to claim 11, Greenawalt discloses a pillow further comprising:

- A pump 38 integral to the pillow.

Pekar discloses the following limitations not disclosed by Greenawalt:

- The pump including a pump bladder 39 having bladder walls.
- An orifice 47 on a bladder wall through which a gas may travel as desired.
- Resilient means 31 located in said pump bladder.
- Said resilient means serving to re-expand said pump bladder after it has been contracted by a squeezing force.
- A one-way valve 16 between said pump bladder and said inflatable gas-containing bladder to permit the pump to force gas into said inflatable gas-containing bladder.



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- A bleed valve 20 on said inflatable gas-containing bladder for permitting gas to escape therefrom.

Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenawalt USPN4528705 in view of Greenawalt USPN4501034.

As to claim 5, Greenawalt USPN4528705 fails to disclose or suggest the following limitations:

- A second inflatable bladder which may be inflated to further adjust orthopedic contour of the pillow.

Greenawalt USPN4501034 discloses a pillow having a second inflatable bladder 32 (col.2, ln.55-60) to increase the possibility of firmness variation. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the pillow disclosed by Greenawalt USPN4528705 to have a second inflatable bladder, as taught by Greenawalt USPN4501034, to increase the possibility of firmness variation.

As to claim 8, Greenawalt USPN4501034 discloses the following limitations not disclosed by Greenawalt USPN4528705:

- A second inflatable bladder 32 which may be inflated to further adjust orthopedic contour of the pillow.

Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenawalt USPN4528705 in view of Pekar USPN5372487.

As to claim 6, Greenawalt discloses a pillow further comprising:

- A pump 38 integral to the pillow.

Greenawalt fails to disclose or suggest the following limitations:





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- The pump including a pump bladder having bladder walls.
- An orifice on a bladder wall through which a gas may travel as desired.
- Resilient means located in said pump bladder.
- Said resilient means serving to re-expand said pump bladder after it has been contracted by a squeezing force.
- A one-way valve between said pump bladder and said inflatable gas-containing bladder to permit the pump to force gas into said inflatable gas-containing bladder.
- A bleed valve on said inflatable gas-containing bladder for permitting gas to escape therefrom.

Pekar discloses a pump having a pump bladder (39), an orifice (47), resilient means (31), a one-way valve (16), and a bleed valve (20), so that the user will not have to release and uncover a hole during each stroke of the pump (col.3, ln.25-27), and because the check valve of Pekar is soft and pliable in construction and lends itself to ease of co-assembly in various types of inflatable bladder applications (col.1, ln.42-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the pump disclosed by Greenawalt with another pump, as taught by Pekar, so the user will not have to release and uncover a hole during each stroke.

As to claim 9, Greenawalt discloses a pillow further comprising:

- A pump (38) integral to the pillow.

Pekar discloses the following limitations not disclosed by Greenawalt

- The pump including a pump bladder 39 having bladder walls.
- An orifice 47 on a bladder wall through which a gas may travel as desired.



- Resilient means 31 located in said pump bladder.
- Said resilient means serving to re-expand said pump bladder after it has been contracted by a squeezing force.
- A one-way valve 16 between said pump bladder and said inflatable gas-containing bladder to permit the pump to force gas into said inflatable gas-containing bladder.
- A bleed valve 20 on said inflatable gas-containing bladder for permitting gas to escape therefrom.

***Response to Arguments***

Applicant's arguments filed 3/18/03 have been fully considered but they are not persuasive.

As to claim 4, Applicant argues (pg.5) that while the firmness of the pillow is allegedly adjustable in Greenawalt, the shape of the pillow does not depart from the pear-shape illustrated in the figures, except that in use, the pillow may be slightly flattened on its bottom wall portion from the weight of a user's head. Applicant further argues that Greenawalt in no way teaches a pillow that is adjusted from a fully flat configuration to fully contoured configuration by inflating a bladder. Finally, applicant argues that Greenawalt does not teach that the contour of the pillow is adjustable in discrete increments. The examiner disagrees with applicant's remarks. The examiner again directs applicant to Figure 5 of Greenawalt, and cited text (col.2, ln.15-18, ln.53-65). It is commonly known that a single folded sheet of urethane is easily deformed, and can thus be made flat under pressure while in the pear shaped form disclosed by Greenawalt. Figure 5 only shows the bottom portion being flattened specifically because the inflatable bag 34 is inflated in the Figure 5 embodiment and renders the large chamber of the pillow to be relatively

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firm. Without inflation/firmness of the inflatable bag, the whole pillow assembly would indeed be flat. The ability of the pillow to flatten is evidenced by the bottom portion in Figure 5 that is completely flat, and because the top portion is made of the same material, it can only be argued that the top material would also easily flatten if the inflatable bag was not filled with air.

Furthermore, the limitation "may be inflated...to fully contoured" is functional language and does not hold patentable weight. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528, (Fed. Cir. 1990). Finally, because the inflatable bag of Greenawalt is inflated by a hand pump, it is obvious that the contour of the pillow is adjusted in discrete increments of air equivalent to squeezing of the pump.

All subsequent arguments to the other claims 1-3 and 5-11 are directed towards the Greenawalt reference argued in claim 4 above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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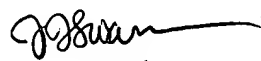
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-1113.

TYH  
April 28, 2003

  
J. J. SWANN  
SUPERVISORY PATENT EXAMINER  
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